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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,707

09/19/2003

Ralph de la Torre

MED-019

1994

36822 7590 12/29/2006
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EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/29/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/666,707

Applicant(s)

DE LA TORRE ET AL.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006 and 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-16, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10, 11, 17, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 13, 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

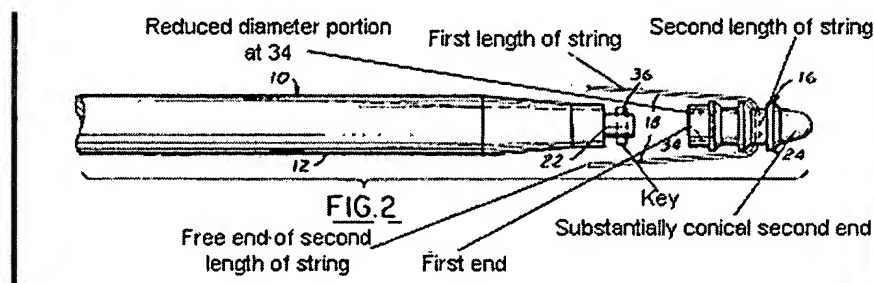
Claims 1-2, 6-8, 10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerier et al. (US Patent Number 5,100,417).

Cerier et al. disclose various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, e.g. 16, having a first end and a second end, wherein the first end of the swivel has a non-circular, i.e. elongate, keyway, 40 and 42, for engaging a key, e.g. 36, on a deployment tool (see figures 3 below and 8). A first length of string extends from the first end of the swivel and a second length of string

Art Unit: 3733

extends from a point substantially midway between the first end and the second end, wherein the second length of string has a free end which does not re-enter the swivel, wherein the visually distinguishable first and second lengths of string having sufficient length such that either is capable of being pulled from outside the body cavity, such that pulling on the second length of string is capable of causing the swivel to swivel off of the key on the deployment tool and be oriented substantially perpendicular to the second length of string, and pulling on the first length of string would cause the swivel to be oriented substantially coaxial to the first length of string (see figures 1 and 9). The swivel is substantially cylindrical with a curved first end and the second end being substantially conical (see figures 3 below and 8).

The swivel has an outer surface, an axial bore extending from the first end to the point substantially midway between the first end and the second end, and a radial bore extending from the axial bore to the surface at the point substantially midway between the first end and the second end (see figures 1-3 and 8-9). The first and second lengths of string are can be part of a single length of string passing through the axial and radial bores (see figure 3 below). The first and second lengths of string are joined together where the axial bore intersects the radial bore (see figure 3 below).



With regard to the statement of intended use and other functional statements, e.g. "for engaging a key on a deployment tool" and "pulling on said second length of string causes said swivel to swivel off the key on the deployment tool," they do not impose any structural limitations on the claims distinguishable over Cerier et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 10-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cope (US Patent Number 6,110,183) in view of Cerier et al. (US Patent Number 5,100,417).

Art Unit: 3733

Cope discloses various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, 30, having a first end, 32 and a second end, 34, wherein the first end of the swivel has a keyway, e.g. the opening at the first end, 32, of the swivel (see figures 8 and 10) for engaging a key, e.g. 23 of 20, (see figures 8 and 10) on a deployment tool (see figures 1 and 7-8). A first length of string, e.g. 70, extends from the first end of the swivel and a second length of string, e.g. 40, extends from a point substantially midway between the first end and the second end wherein the second length of string has a free end which does not re-enter the swivel (see figure 7), wherein the visually distinguishable first and second lengths of string having sufficient length such that either may be pulled from outside the body cavity, such that pulling on the second length of string is capable of causing the swivel to swivel off of the key on the deployment tool and be oriented substantially perpendicular to the second length of string, and pulling on the first length of string to be oriented substantially coaxial to the first length of string (see figures 13-17). The swivel is substantially cylindrical with a curved first end and the second end being substantially conical (see figures 4-6). The swivel has a surface groove, 183, extending substantially from the first end to the point substantially midway between the first end and the second end, the surface groove having a depth sufficient to receive the second string (see figures 20-21). The swivel has a reduced diameter portion, e.g. 50 (see figures 7, 10 and 18-21).

The swivel has an outer surface, an axial bore extending from the first end to the point substantially midway between the first end and the second end, and a radial bore extending from the axial bore to the surface at the point substantially midway between

Art Unit: 3733

the first end and the second end (see figures 4-6 and 20-21). The first and second lengths of string are capable of being part of a single length of string passing through the axial and radial bores (see figure 7). The first and second lengths of string are joined together where the axial bore intersects the radial bore (see figure 7).

The surgical retractor device of Cope further comprises a hollow tube, 10, having a proximal end and a distal end, the first end of the swivel being removably mounted in the distal end of the tube, and a pushrod, 20, having a proximal end and a distal end, the pushrod extending through the hollow tube with the distal end of the pushrod facing the first end of the swivel (see figures 3 and 8).

Cope discloses the claimed invention except the swivel having a non-circular keyway. Cerier et al. disclose various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, e.g. 16, having a first end and a second end, wherein the first end of the swivel has a non-circular, i.e. elongate, keyway, 40 and 42, for engaging a key, e.g. 36, on a deployment tool (see figure 3 above). Cerier et al. teach the use of such a dimensioned keyway to create a "force fit mating relationship and assembly" between the swivel and the deployment tool (see column 3, lines 46-48). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cope with the swivel having a non-circular keyway in view of Cerier et al., in order to create a "force fit mating relationship and assembly" between the swivel and the deployment tool.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cope (US Patent Number 6,110,183) in view of Pedlick et al. (US Patent Number 5,961,538).

Cope discloses the claimed invention except for the first length of string and the second length of string being different colors. Pedlick et al. discloses a surgical retractor device comprising sutures of different colors and teaches "the sutures being identifiable by color such that the suture can be distinguished from other sutures of other colors" (see column 5, lines 41-43). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cope with the first length of string and the second length of string being different colors, in view of Pedlick et al., in order to identify/distinguish the first length of string from the second length of string.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cerier et al. (US Patent Number 5,100,417) in view of Pedlick et al. (US Patent Number 5,961,538).

Cerier et al. disclose the claimed invention except for the first length of string and the second length of string being different colors. Pedlick et al. discloses a surgical retractor device comprising sutures of different colors and teaches "the sutures being identifiable by color such that the suture can be distinguished from other sutures of other colors" (see column 5, lines 41-43). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cerier et al. with the first length of string and the second length of string being different colors, in view of Pedlick et al., in order to identify/distinguish the first length of string from the second length of string.

Allowable Subject Matter

Claim 12 is objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the Cragg reference have been fully considered and are persuasive. The rejection under Cragg has been withdrawn.

Applicant's arguments filed on September 13, 2006 regarding the Cerier et al. and Cope references have been fully considered, but they are not persuasive. Regarding the Cerier et al. reference, please see figure 3 above and explanations. In addition, applicant is claiming a first length of string and a second length of string, both of which are considered broad. A first length of string and a second length of string can be considered anywhere on a piece of string. Furthermore, examiner respectfully disagrees with applicant regarding the length of the string, since the string would be long enough such that it may be pulled from outside the body cavity and pulling on it would cause the anchor to swivel off the deployment tool.

Regarding the Cope reference, as stated above, Cope discloses various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, 30, having a first end, 32 and a second end, 34, wherein the first end of the swivel has a keyway, e.g. the opening at the first end, 32, of the swivel (see figures 8 and 10) for engaging a key, e.g. 23 of 20, (see figures 8 and 10) on a deployment tool (see figures 1 and 7-8). Furthermore, as stated above, Cope discloses the claimed

Art Unit: 3733

invention except the swivel having a non-circular keyway. Cerier et al. disclose various embodiments of a surgical retractor for use within a body cavity, comprising an elongate swivel, e.g. 16, having a first end and a second end, wherein the first end of the swivel has a non-circular, i.e. elongate, keyway, 40 and 42, for engaging a key, e.g. 36, on a deployment tool (see figure 3 above). Cerier et al. teach the use of such a dimensioned keyway to create a "force fit mating relationship and assembly" between the swivel and the deployment tool (see column 3, lines 46-48). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Cope with the swivel having a non-circular keyway in view of Cerier et al., in order to create a "force fit mating relationship and assembly" between the swivel and the deployment tool. In addition, it is possible to simultaneously deploy the pushrod 20 of Cope and pull on suture 40 in order to disengage the anchor 30 or 35 from the pushrod.

Examiner understands applicant's explanations regarding the importance of the non-circular keyway as disclosed in the specification. However, applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner suggests that applicant include the functional significance of the non-circular keyway and key in relationship to the swivel and pushrod, e.g. "use of a non-circular key and keyway allow the swivel to be deployed by moving the pushrod 18 towards the patient" (see page 11, lines 15-16, of remarks), into claim 1. Furthermore, it is noted that the keyway is disclosed as non-circular in claim 1, but the key is not disclosed as non-circular in claim 1.

Art Unit: 3733

Conclusion

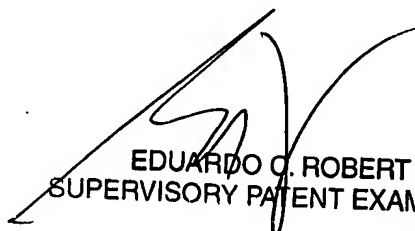
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER